### REMARKS

Claims 1-38 and 43-50 are currently pending in the application. By this amendment, claims 1, 12, 16, 24, and 48 are amended for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for the amendments is provided in the claims as originally filed and at page 5 of the specification. Reconsideration of the rejected claims is respectfully requested in view of the above amendments and the following remarks.

#### Allowed Claims

Applicant appreciates the indication that claims 16-18 and 36-38 contain allowable subject matter, subject to the § 101 rejection discussed below and a final update search. Applicant notes that claim 16 is herein amended to be an independent claim, such that claims 16-18 are in condition for allowance. However, Applicant submits that all of the claims are in condition for allowance for the following reasons.

#### Acknowledgement of Receipt of Drawings

Applicant notes with appreciation the Examiner's acknowledgment that Applicant's drawings are accepted.

#### Information Disclosure Statement

Applicant would like to express appreciation to the Examiner for acknowledgment of Applicant's Information Disclosure Statement by the return of the initialed PTO-1449 forms.

#### 35 U.S.C. § 101 Rejection

Claims 1-38 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner asserts that claims 1-38 do not appear to require any computer hardware to implement the claimed invention. Applicant first notes that independent claims 1 and 24 are both method claims, such that there is no requirement to include computer hardware as an element of the claim. Rather, the requirements of § 101 are satisfied when the claimed invention as a whole produces a useful, tangible, and concrete result. The Examiner's attention is directed to MPEP § 2107, which provides the following examination guidelines for the utility requirement:

> Office personnel are to adhere to the following procedures when reviewing patent applications for compliance with the "useful invention" ("utility") requirement of 35 U.S.C. 101 and 112, first paragraph.
> (B) Review the claims and the supporting written description to determine if the applicant has asserted for the claimed invention any specific and substantial utility that is credible:
> (1) If the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.

Applicant submits that the following passages from page 5 of the specification of the instant application constitute an assertion that the claimed invention is useful for a particular practical purpose:

> This invention provides a full feature rich text edit capability for a standard Web browser and other applications. In particular, the present invention provides a method and system to consistently represent rich text in memory structure in order to facilitate editing and managing documents containing such rich text. These memory structures may be resident on a computer, server or other known hardware. The documents may include, for example, html documents presented via a web browser or other web based applications. These documents may contain text, tables, images, links and the like in which the system and method of the present invention represents such elements as rich text in such documents. By utilizing the system and method of the present invention, it is now possible to edit and save such documents in many types of environments thus providing flexibly and robust management and control capabilities.

As demonstrated by these passages, Applicant has clearly asserted that the claimed invention is useful for a particular purpose that would be considered credible by a skilled artisan. Therefore, the claimed invention as a whole has a useful result. As such, the Examiner has improperly imposed a rejection based on a lack of utility, and the rejection of claims 1-38 for lack of utility should be withdrawn.

Nonetheless, in order to further the prosecution of this application, Applicant has amended independent claims 1 and 24 to more clearly define the invention by further reciting applications "as implemented in a machine." Claims 2-23 and claims 25-38 are dependent claims, depending from claims 1 and 24 respectively. Therefore, in view of the above remarks and amendments, Applicant respectfully requests withdrawal of the 35 U.S.C. § 101 rejection of claims 1-38.

### *35 U.S.C. § 102(a) Rejection*

Claims 1-7, 19-20, and 48-50 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,480,206 issued to Prinzing (hereinafter, "Prinzing '206"). This rejection is respectfully traversed.

In order to support a rejection of a claim under 35 U.S.C. § 102, a single prior art reference must contain each and every limitation of the claim, either expressly or under the doctrine of inherency. Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1570 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988). The Examiner asserts that Prinzing '206 shows all the elements of independent claims 1and 48. Applicants respectfully disagree.

The present invention generally relates to rich text capability for Web based applications and browsers, and more specifically, to a system and method for representing and controlling rich text in memory and various text representations.

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*Independent Claim 1*

As amended, claim 1 recites in relevant part, "A method of representing and managing rich text for use by Web based applications and browsers ...." The Examiner acknowledges that Prinzing '206 does not specifically teach the use of Web based applications or browsers. (See Office Action, page 14.) Accordingly, Applicant respectfully submits that Prinzing '206 fails to disclose each and every limitation of claim 1.

*Independent Claim 48*

Additionally, as amended claim 48 recites in relevant part:

> A computer program product comprising a computer usable medium having a computer readable program code embodied in the medium, the computer program product includes:
> a first computer program code to provide one or more classes for use by Web based applications and browsers ...

The Examiner acknowledges that Prinzing '206 does not specifically teach the use of Web based applications or browsers. (See Office Action, page 14.) Accordingly, Applicant respectfully submits that Prinzing '206 fails to disclose each and every limitation of claim 48.

*Dependent Claims 2-7, 19-20, and 48-50*

Claims 2-7, 19-20, and 48-50 are dependent claims, depending from respective distinguishable base claims. Accordingly, these claims should also be in condition for allowance by virtue of their dependencies. Accordingly, Applicant respectfully requests that the rejection over claims 1-7, 19-20, and 48-50 be withdrawn.

**35 U.S.C. § 103(a) Rejection**

Claims 8-15, 24-31, 33-35, 43-45, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Prinzing '206 in view of U.S. Patent No. 6,470,364 issued to Prinzing (hereinafter, "Prinzing '364"). This rejection is respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie case* of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. The Examiner asserts that the applied prior art teaches or suggests all of the features of the claimed invention. Applicants respectfully disagree and submit that the Examiner has failed to establish a *prima facie* case of obviousness.

*Independent Claim 43*

Claim 43 recites:

An apparatus for providing a means for representing and managing rich text for use by Web based applications and browsers, the apparatus comprising:
a component representing rich text in a memory structure representation;
a component providing one or more classes for use by the Web based applications and browsers to create the memory structure representation, wherein the one or more classes includes,
a) a rich text list class for managing one or more rich text nodes and
b) a rich text class to create one or more rich text nodes each representing a unit of rich text and its attributes.

With regard to claim 43, the Examiner acknowledges that Prinzing '206 fails to teach the use of Web based applications or browsers. The Examiner asserts that Prinzing '364 teaches this feature (citing to Prinzing '364, col. 4, line 63 – col. 5, line 16 col. 11, lines 45-49, and table 1) and the Examiner is of the opinion that it would have been obvious to combine the teaching of Prinzing '206 with the teaching of Prinzing '364. Even assuming *arguendo* that it would have been obvious to combine the two Prinzing references, which Applicant does not concede, such combination does not teach or suggest all the limitations of claim 43.

Specifically, the cited portions of Prinzing '364 do not teach the use of Web based applications or browsers. Rather, the reference discloses the different types of text that may be used in the GUI application. By listing such types of text, including Java source code and HTML source code, though, Prinzing '364 does not teach the feature "representing and managing rich text for use by Web based applications and browsers." Rather, the cited portion of Prinzing '364 is silent as to whether such a GUI application using Java or other source code is on a stand-alone computer, or connected to a network, much less is a Web based application or a browser.

Additionally, although Prinzing '364 does teach that "a new editor kit can be downloaded from a server on the Internet," this passage does not teach that the new editor kit itself is a Web based application or browser. In fact, that Prinzing '364 teaches that the new editor kit can be "downloaded" suggests that the new editor kit is not in fact a Web based application or browser, but rather, is resident and functions on the user's computer, not through the internet.

Moreover, as discussed above, Applicant submits that Prinzing '364 does not compensate for the deficiencies in Prinzing '206 discussed above with reference to claim 1. For these reasons, Applicants submit that any proper combination of Prinzing '206 and '364 would not teach all the features of at least claim 43.

### _Independent Claim 24_

As amended, claim 24 recites in relevant part:

> A method of representing and managing documents having rich text for use by Web based applications and browsers as implemented in a machine, ....

Claim 24 "is similarly rejected under the same rationale" as claim 43. Applicant submits that claim 24 is allowable for reasons similar to the reasons set forth above with respect to claim 43, insofar as claim 43 recites features of an apparatus similar to the

above-noted features of the method recited in claim 24. That is, Prinzing '364 does not compensate for the deficiencies of Prinzing '206 noted above with reference to claim 1. Thus, Applicants submit that any proper combination of Prinzing '206 and '364 would not teach all the features of at least claim 24.

## *Dependent Claims 8-15, 25-31, 33-35, and 44-45*

Claims 8-15, 25-31, 33-35, and 44-45 are dependent claims, depending from respective distinguishable base claims. Accordingly, these claims should also be in condition for allowance by virtue of their dependencies. Accordingly, Applicant respectfully requests that the rejection over claims 8-15, 24-31, 33-35, 43-45, and 47 be withdrawn.

## CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,

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